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5/31/00

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Wolfson

Cancellation No. 26,378

Kappa Books, Inc.

v.

Herbko International,
Inc.

A petition to cancel respondent's registration for the mark CROSSWORD COMPANION and Design, for a "crossword puzzle system, namely, paper crossword puzzle rolls and hand held puzzle roll scrolling device sold as a unit and crossword puzzle replacement rolls sold separately" was filed by petitioner on June 24, 1997. As grounds therefor, petitioner alleged prior use of the mark CROSSWORD COMPANION on crossword puzzle books, and a likelihood of confusion. Respondent, in its answer, denied the salient allegations of the petition.

On March 18, 1998, petitioner filed a motion for summary judgment on the grounds of priority of use and likelihood of confusion. Respondent, after having been granted time to conduct discovery under Fed. R. Civ. P.

56(f), filed a response to petitioner's motion on December 14, 1998.¹

The record includes the declaration of Ronald Gold, petitioner's president. In support of petitioner's motion, Mr. Gold states that petitioner first sold CROSSWORD COMPANION puzzle books to WalMart, a U.S. department store chain, in 1993. Two shipments of books were made in 1993; the first consisted of 373,200 books and the second consisted of 683,000 books. No significant sales took place in 1994. Petitioner resumed sales of its CROSSWORD COMPANION puzzle books in 1995 and sold 918,705 books in the years 1995-1997. Sales were made to various retail stores throughout the United States.

Petitioner's CROSSWORD COMPANION books are presently sold as part of a set consisting of four puzzle books sold together.² In 1997, petitioner filed an application to register CROSSWORD COMPANION for "crossword puzzle books published in a series." As a specimen of use in the application, petitioner submitted copies of a CROSSWORD

¹ The parties' stipulated motion, filed September 4, 1998, to extend to November 27, 1998 respondent's time to respond to the motion for summary judgment and respondent's motion to extend further its time to respond to petitioner's motion for summary judgment, filed via certificate of mailing on November 25, 1998, are granted. Respondent has shown good cause for the further extension requested. See Fed. R. Civ. P. 6(b); and TBMP §509.01.

² The four books sold in the set are: "Crossword Companion," "Fill-Ins Companion," "Word-Find Companion #1" and "Word-Find Companion #2."

COMPANION book bearing the insignia "22" to indicate the volume number.

Exhibits to Mr. Gold's declaration include a CROSSWORD COMPANION puzzle book dated 1997 bearing the insignia "26" to indicate the volume number and the words "New Series" on the cover; a print-out of petitioner's sales activity for the time period 1995-1997; copies of the prosecution histories of both petitioner's application and respondent's registration; and copies of several advertisements of respondent's product.

Respondent's application for the mark CROSSWORD COMPANION was filed on June 29, 1994, asserting a bona fide intent to use the mark in commerce. An amendment to allege use was filed thereafter, claiming a date of first use in commerce of September 22, 1994. Respondent's product has been offered for sale by Marshalls, a U.S. discount chain store and by K-Mart, a department store chain similar to WalMart. (Gold declaration, paragraph 11). In addition, respondent markets its product through SKYMALL, an airlines magazine, THE SHARPER IMAGE, and through AVON mail order catalogs (Gold declaration, paragraph 11 and petitioner's supplemental exhibit 8).

In opposition to petitioner's motion, respondent argues that the mark, CROSSWORD COMPANION, is the title of a single work, and as such cannot function as a trademark unless and

until it acquires secondary meaning. Respondent further alleges that petitioner has not established the absence of a genuine issue as to whether there is a likelihood of confusion.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). Petitioner, as the party moving for summary judgment, has the burden of demonstrating the absence of any genuine issues of material fact. See Celotex Corp. v. Catrett, 477 U.S. 317 (1986); Sweats Fashions Inc. v. Pannill Knitting Co., 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. See Opryland USA Inc. v. Great American Music Show Inc., 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

PRIORITY

Although there is no genuine issue that petitioner first used the designation CROSSWORD COMPANION prior to the filing of the application which has matured into

respondent's registration,³ respondent is essentially arguing that petitioner did not establish prior trademark rights in CROSSWORD COMPANION because its prior use was only as the title of a single work. However, there is no genuine issue that petitioner continued to use its mark on a series of crossword puzzle books, and that its use on the books in 1993 was a trademark use on the first of the books in the series.⁴ Accordingly, as a matter of law, we find that petitioner established rights in the trademark CROSSWORD COMPANION in 1993 and thus petitioner has priority.

This case is not unlike an "analogous use case," where non-technical trademark use of a term creates an inchoate right that its owner may perfect upon making a technical trademark use of the term, so long as the analogous use is of such a nature and extent that it creates a proprietary right in the user deserving of protection, and the technical use is commenced within a reasonable time. See Era Corp. v. Electronic Realty Associates, Inc., 211 USPQ 734, 745 (TTAB 1981); Dyneer Corporation v. Automotive Products, plc; 37 USPQ2d 1251 (TTAB 1995). Petitioner's initial shipments to WalMart in 1993 were sufficient to create such proprietary

³ The filing date of an intent-to-use application is the constructive use date of the mark.

⁴ Reviewing the evidence in the light most favorable to respondent as the non-moving party, see Opryland, supra, 23 USPQ2d at 1472, we have assumed that petitioner did not publish a second (i.e., different) book of crossword puzzles until 1995.

rights, since they were in fact followed by shipments of additional sets of books in 1995.

Accordingly, petitioner has established its priority of use.

LIKELIHOOD OF CONFUSION

Our determination of likelihood of confusion is based on the factors set forth in In re E. I. DuPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

There is no genuine issue that the marks are virtually identical. Although respondent's mark includes a design feature, consisting of the addition of boxes resembling part of a crossword puzzle surrounding each letter, such is not sufficient to distinguish the marks. Where a mark comprises both a word and a design, it is the word portion of the mark which is most likely to be impressed upon the purchaser's memory and serve as an indication of origin, since it is the word which would be used by purchasers in requesting the goods or services. See In re Appetito Provisions Co. Inc., 3 USPQ2d 1553, 1554 (TTAB 1987).

Nor is there a genuine issue that the parties' goods are extremely similar. Both are crossword puzzles, and the

only difference between them is that petitioner's crossword puzzles are provided in the form of a paperback book, while respondent's are provided in a hand-held scrolling device. Both would appeal to the same group of consumers, namely, those who enjoy crossword puzzles.

We also find no genuine issue that the goods are sold in the same channels of trade. Petitioner's president stated that he has personally seen respondent's product for sale in Marshalls and K-Mart, retail stores similar to WalMart, where petitioner distributes its books.

Respondent has argued, without any supporting evidence, that there are genuine issues regarding the similarity of the goods and the channels of trade. Fed. R. Civ. P.56(e) provides that when a motion for summary judgment is made and supported by affidavit, an adverse party may not rest upon the mere allegations or denials of the adverse party's pleading, but must by affidavit set forth specific facts showing that there is a genuine issue for trial.

Petitioner has demonstrated that there is no genuine issue as to the marks, goods, classes of consumers and channels of trade. Petitioner has established priority and has shown that a likelihood of confusion exists. Respondent has not shown the existence of a genuine dispute as to any material fact regarding the issues of priority or likelihood of confusion.

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Accordingly, petitioner's motion for summary judgment is granted; the petition to cancel is hereby granted; judgment is entered against respondent; and Registration No. 1,914,863 will be cancelled in due course.

E. J. Seeherman

G. D. Hohein

C. E. Walters
Administrative Trademark Judges
Trademark Trial and Appeal Board